



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,411	02/20/2002	Avner Schneur	EMT-003	1565
51414 7590 01/02/2009 GOODWIN PROCTER LLP PATENT ADMINISTRATOR 53 STATE STREET EXCHANGE PLACE BOSTON, MA 02109-2881				
EXAMINER				
SHAAWAT, MUSSA A				
ART UNIT		PAPER NUMBER		
3627				
NOTIFICATION DATE		DELIVERY MODE		
01/02/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PatentBos@goodwinprocter.com

hmcpeake@goodwinprocter.com

glenn.williams@goodwinprocter.com

### Office Action Summary

**Application No.**

10/081,411

**Applicant(s)**

SCHNEUR ET AL.

**Examiner**

MUSSA A. SHAAWAT

**Art Unit**

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date 9/11/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is in response to the amendment filed on 09/11/2008. Claims 1-20 are pending examination.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 8-14 and 19-20 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

Claims 8-14 and 19-20 are directed to **a computer program**, which do not fall within the four statutory classes of 101. Software modules are non-statutory subject matter unless embodied within a computer-readable storage medium such as computer hard disk or the like. Appropriate corrections are required to overcome the 101 rejections.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Li et al., US PG. Pub. No. (2003/0004850) referred to hereinafter as Li.

As per claims 1, Li teaches a computer-implemented method for determining an optimal award schedule for satisfying a purchase requisition, the method comprising: receiving over a computer network, from each of a plurality of candidate suppliers, a corresponding plurality of bids (Abstract, Para 0005); receiving, from a candidate supplier over said computer network, an explicit offer of a business-volume discount that is triggered when a purchase from the candidate supplier of at least one unit of a first qualifying item and at least one unit of a second qualifying item has an aggregated volume within a defined volume interval (see at least Para 0114, 0014 0038); and determining by a processor an optimal award schedule comprising an optimal combination of suppliers and a list of items to be ordered from each supplier to at least partially satisfy the purchase requisition utilizing the explicit offer of a business volume discount (see at least Abstract, Para 0006, 0016 and 0064).

As per claim 2, Li teaches a method of claim 1, wherein receiving a business-volume discount offer comprises receiving a business-volume discount offer in which a business-volume discount is triggered on the basis of purchases of items belonging a first category of items and no business-volume discount is triggered on the basis of purchases of items belonging to a second category of items (see at least Abstract, Para 0006, 0016 and 0064).

As per claim 3, Li teaches a method of claim 2, wherein receiving a corresponding plurality of bids comprises receiving, from the at least one candidate supplier, a first bid in which each item recited in the first bid belongs to no more that one item-category (see at least Para 0097, 0129, 0131).

As per claim 4, Li teaches a method of claim 2, wherein receiving a corresponding plurality of bids comprises receiving, from the at least one candidate supplier, a first bid in which at least one item recited in the first bid belongs to both a first item-category and a second item-category (see at least Para 0097).

As per claim 5, Li teaches a method of claim 4, wherein determining an optimal award schedule comprises constraining the optimal award schedule such that a purchase of the at least one qualifying item contributes to a business volume discount associated with at most one of the first and second item-categories (See at least Para 0014 and 0064).

As per claim 6, Li teaches a method of claim 1, wherein receiving an offer of a business-volume discount comprises receiving a business-volume discount offer that defines a plurality of volume intervals, each of the volume intervals being associated with a corresponding discount to be offered when the volume of an aggregate purchase of at least two qualifying items from the at least one candidate supplier is within the volume interval (see at least Para 0114).

As per claim 7, Li teaches a method of claim 1, wherein receiving an offer of a business-volume discount comprises receiving a business-volume discount offer in

which the defined volume interval has a lower bound defined by a volume threshold and no upper bound (see at least Para 0114).

As per claim 15, Li teaches a method of claim 1 further comprising imposing, by a party other than a candidate supplier, a private buyer constraint prior to determining the optimal award schedule (See at least Para 0019, 0062-0065, 0077-0078).

As per claim 16, Li teaches a method of claim 15 further comprising changing an imposed private buyer constraint and redetermining the optimal award schedule using the changed private buyer constraint (see at least Para 0065).

As per claim 17, Li teaches a method of claim 1 further comprising storing a supplier profile corresponding to a candidate supplier (see at least Para 0079-0080, 0103).

As per claim 18, Li teaches a method of claim 17 wherein determining an optimal award schedule considers a stored supplier profile corresponding to a candidate supplier (see at least Para 0104).

As per claims 8-14 and 19-20, the limitations of claims 8-14 and 19-20 are similar to the limitations of claims 1-7 and 15-18.

### ***Response to Arguments***

5. Applicant's arguments have been considered but are not persuasive. In particular applicant argues that, A) Li fails to teach, "determining by a processor an optimal award schedule comprising an optimal combination of suppliers and a list of items to be ordered from each supplier to at least partially satisfy the purchase

requisition utilizing the explicit offer of a business volume discount"; B) applicant is traversing the 101 rejection in the previous rejection.

In response to A) the examiner respectfully disagrees. Applicant is reminded that claims must be given their broadest reasonable interpretation. Li teaches determining by a processor an optimal award schedule comprising an optimal combination of suppliers and a list of items to be ordered from each supplier to at least partially satisfy the purchase requisition utilizing the explicit offer of a business volume discount (see at least Para 0114-0117, 0124-0128, 0096, 0097, 0011-0014 and 0006-0007, and claims 27, 33, 38 40, 42). Therefore Li meets the scope of the limitation as currently claimed.

In response to B), the 101 rejection on claims 8-14 and 19-20 is maintained. The claims have to recite that the program is embodied in a computer readable medium and executed by a computer. The claims as written right now are directed to **a computer program**, which do not fall within the four statutory classes of 101. Software modules are non-statutory subject matter unless embodied within a computer-readable storage medium such as computer hard disk or the like. Appropriate corrections are required to overcome the 101 rejections.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to form 892 for cited references.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MUSSA A. SHAAWAT whose telephone number is (571)272-2945. The examiner can normally be reached on Mon-Fri (8am-5:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mussa A Shaawat/  
Examiner, Art Unit 3627  
July 17, 2008

/F. Ryan Zeender/  
Supervisory Patent Examiner, Art  
Unit 3627